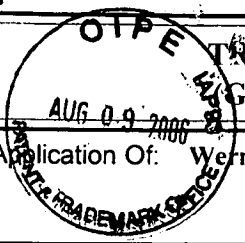


1FW



TRANSMITTAL LETTER (General - Patent Pending)	Docket No. LASP:130US
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In Re Application Of: **Werner KNEBEL**

Application No. 10/656,615	Filing Date 06/15/2006	Examiner Thong Q. Nguyen	Customer No. 24041	Group Art Unit 2872	Confirmation No. 3004
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Title: **SCANNING MICROSCOPE**

COMMISSIONER FOR PATENTS:

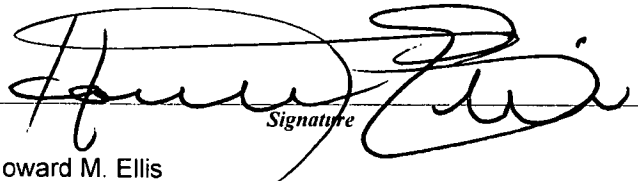
Transmitted herewith is:

- Substitute Specification - - clean version (37 CFR 1.125(c))
- Submission of English Language Version of IPER under 35 USC 371(c)(5) w/ copy of IPER
- Acknowledgement Postcard
- 4 sheets of drawings

in the above identified application.

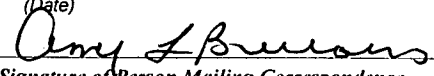
- ☒ No additional fee is required.
- ☐ A check in the amount of _____ is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. **50-0822** as described below.
 - ☐ Charge the amount of _____
 - ☒ Credit any overpayment.
 - ☒ Charge any additional fee required.
- ☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.


Signature

Dated: August 7, 2006

Howard M. Ellis
Registration No. 25,856
SIMPSON & SIMPSON, PLLC
5555 Main Street
Williamsville, New York 14221
716-626-1564 - Telephone
716-626-0366 - Facsimile

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on August 7, 2006 (Date)	
 Signature of Person Mailing Correspondence	
Amy Burrows Typed or Printed Name of Person Mailing Correspondence	

cc:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Werner Knebel
Serial No.: 10/565,615
Filing Date: June 15, 2006
Title: SCANNING MICROSCOPE
Attorney Ref: LASP:130US
Group Art Unit: 2872
Examiner: Thong Q. Nguyen

<u>Certificate of Mailing by First Class Mail</u>	
I certify that this document is being deposited on August 7, 2006 with sufficient postage with the U.S. Postal Service as first class mail under 37 C.F.R. §1.8 and is addressed to the Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.	
<u>Amy L Burrows</u> Name: Amy Burrows	<u>8/7/06</u> Date

**SUBMISSION OF ENGLISH LANGUAGE VERSION OF THE INTERNATIONAL
PRELIMINARY EXAMINATION REPORT
UNDER 35 U.S.C. 371(c)(5)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant is submitting herewith an English language version of the IPER issued by the International Bureau (WIPO) on June 8, 2006 for International Application PCT/EP2004/051606 from which the caption US application was filed.

The publications cited in the IPER were furnished to the Office with applicant's IDS, filed January 24, 2006.

Please consider the IPER during examination of this application.

Respectfully submitted,

Howard M. Ellis
Attorney of Record
Registration No. 25,856

August 7, 2006

RECEIVED

in the INTERNATIONAL BUREAU

PCT

JUL 17 2006

SIMPSON & SIMPSON

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY
(CHAPTER I OR CHAPTER II
OF THE PATENT COOPERATION TREATY)
(PCT Rules 44bis.3(c) and 72.2)

REICHERT, Werner F.
Leica Microsystems AG
Corporate Patents + Trademarks Department
Ernst-Leitz-Strasse 17-37
35578 Wetzlar
ALLEMAGNE

Leica Wetzlar	
Eing.: 14. Juni 2006	
Konzernstelle Patente + Marken	
FRIST:	

Date of mailing (day/month/year) 08 June 2006 (08.06.2006)	IMPORTANT NOTIFICATION
Applicant's or agent's file reference E 0710 WO	
International application No. PCT/EP2004/051606	International filing date (day/month/year) 26 July 2004 (26.07.2004)
Applicant LEICA MICROSYSTEMS HEIDELBERG GMBH et al	

1. Transmittal of the translation to the applicant.



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

None

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Authorized officer

Ellen Moyse

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference E 0710 WO	FOR FURTHER ACTION		See item 4 below
International application No. PCT/EP2004/051606	International filing date (<i>day/month/year</i>) 26 July 2004 (26.07.2004)	Priority date (<i>day/month/year</i>) 26 July 2003 (26.07.2003)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant LEICA MICROSYSTEMS HEIDELBERG GMBH			

1.	This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).		
2.	This REPORT consists of a total of 7 sheets, including this cover sheet.		
In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.			
3.	This report contains indications relating to the following items:		
<input checked="" type="checkbox"/>	Box No. I	Basis of the report	
<input checked="" type="checkbox"/>	Box No. II	Priority	
<input type="checkbox"/>	Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	
<input type="checkbox"/>	Box No. IV	Lack of unity of invention	
<input checked="" type="checkbox"/>	Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	
<input type="checkbox"/>	Box No. VI	Certain documents cited	
<input type="checkbox"/>	Box No. VII	Certain defects in the international application	
<input type="checkbox"/>	Box No. VIII	Certain observations on the international application	
4.	The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).		

Date of issuance of this report 29 May 2006 (29.05.2006)
Authorized officer Ellen Moyse
Telephone No. +41 22 338 89 75

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland
Facsimile No. +41 22 740 14 35

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

Translation

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

E 0710 WO

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/EP2004/051606

International filing date (day/month/year)

26.07.2004

Priority date (day/month/year)

26.07.2003

International Patent Classification (IPC) or both national classification and IPC

Applicant

LEICA MICROSYSTEMS HEIDELBERG GMBH

1. This opinion contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|--|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the opinion |
| <input checked="" type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP

Authorized officer

Facsimile No.

Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/051606

Box No. I	Basis of this opinion
1.	<p>With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.</p> <p><input type="checkbox"/> This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).</p>
2.	<p>With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:</p> <p>a. type of material</p> <p><input type="checkbox"/> a sequence listing</p> <p><input type="checkbox"/> table(s) related to the sequence listing</p> <p>b. format of material</p> <p><input type="checkbox"/> in written format</p> <p><input type="checkbox"/> in computer readable form</p> <p>c. time of filing/furnishing</p> <p><input type="checkbox"/> contained in the international application as filed.</p> <p><input type="checkbox"/> filed together with the international application in computer readable form.</p> <p><input type="checkbox"/> furnished subsequently to this Authority for the purposes of search.</p>
3.	<p><input type="checkbox"/> In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.</p>
4.	<p>Additional comments:</p>

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/051606

Box No. II Priority

1. ☒ The following document has not yet been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date in the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43bis.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/051606

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	7, 10	YES
	Claims	1-6, 8, 9, 11-16	NO
Inventive step (IS)	Claims		YES
	Claims	1-16	NO
Industrial applicability (IA)	Claims	1-16	YES
	Claims		NO

2. Citations and explanations:

Reference is made to the following documents from the international search report:

D1: WO 02/14811 A (DRABENSTEDT ALEXANDER; MG MICROSCOPE GMBH (DE)) 21 February 2002 (2002-02-21)

D2: DE 100 04 191 A (AXON INSTR INC) 7 December 2000 (2000-12-07)

D3: DE 198 59 314 A (ZEISS CARL JENA GMBH) 29 June 2000 (2000-06-29)

D4: US 2002/097485 A1 (AOSHIMA MIKIO) 25 July 2002 (2002-07-25)

D5: DE 202 06 153 U (LEICA MICROSYSTEMS) 27 June 2002 (2002-06-27)

D6: WO 03/012516 A (BIRK HOLGER; LEICA MICROSYSTEMS (DE)) 13 February 2003 (2003-02-13)

D7: US 2003/133189 A1 (ENGELHARDT JOHANN ET AL) 17 July 2003 (2003-07-17)

D9: EP 0 495 930 A (UNIV MINNESOTA) 29 July 1992 (1992-07-29)

1.1 The present application does not meet the requirements of PCT Article 33(1) because the subject-matter of claim 1 is not novel within the meaning of PCT Article 33(2).

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/051606

Box No. V

Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

Document D1 (see, in particular, figure 3 and page 9, and also figure 1 and the rest of the description) discloses (the references between parentheses relate to said document):

Scanning microscope (see abstract, with page 5, lines 4-10) with at least one light source (9), defining an illumination beam path (see 10) and with a spectral detector (6) for detection of the detection light (2) emerging from the sample, which detector defines a detection beam path and comprises a spectrally splitting component (3) the spectrally splitting component separating the illumination and detection beam paths (see page 9, lines 13-15, page 7, second paragraph, figure 3).

D1 thus discloses all the features of claim 1.

Independently of the above, each of documents D2-D7 and D9 (see the corresponding passages specified in the search report) considered by themselves also discloses all the features of claim 1 and therefore anticipates the novelty thereof (PCT Article 33(2)).

NB: It is noted with regard to the disclosure of D4, D5 and D7 that the term "spectral detector" need not be understood restrictively, rather any detector comes under this since no detector covers an infinitely large spectral range (PCT Article 6). It is noted with regard to the disclosure of D2, figure 8, that every prism is a spectrally splitting component; therefore, claim 1 of the application

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/051606

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

encompasses any prism, *inter alia* because it does not define that the component within the claimed device acts as a spectrally splitting component. (PCT Article 6).

1.2 Dependent claims 2-6, 8,9,11-16 do not contain any features which, in combination with the features of any claim to which they refer, meet the PCT requirements for novelty, see documents D1-D7 and D9 and the corresponding passages specified in the search report (PCT Article 33(3)).

The features defined in claim 7 are not inventive because they represent to a person skilled in the art obvious variations for the passage of a light beam through a prism, cf. D4 for instance. Claim 10 is not inventive because an arrangement with these additional features is known from D2, figure 7 (PCT Article 33(3)).